



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,196	02/25/2004	Joseph J. Randazzo	3691-654	3373

23117 7590 02/04/2005

NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
----------	--------------

3612

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,196

Applicant(s)

RANDAZZO, JOSEPH J.

Examiner

Hilary Gutman

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/25/04 & 7/22/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to because in Figures 2 and 3, the lead line for reference number "30" is not apparently pointing to anything. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: on page 6, [0024], line 2, "substrate 1" should be "substrate 21". Appropriate correction is required.
3. The use of the trademark Nylex has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "first and second elongated approximately parallel legs" in lines 2-3, "a respective major surface" in line 3, and "legs" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 9-10, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dupuy.

For claim 9, Dupuy (5,475,947) discloses applique for use at a pillar area of a vehicle (Figure 2b), the applique comprising: a polymer inclusive substrate 18, the polymer inclusive substrate including an interior surface to be closest to a vehicle window and an exterior surface to be further from the window than is the interior surface; a polymer inclusive flexible thermoplastic elastomer portion 61 including at least one flexible lip or leg for engaging a surface or edge of the vehicle window 14, wherein said substrate and said thermoplastic elastomer portion are “bonded” at least on part of said interior surface of the substrate which is to be closest to the vehicle window; wherein said thermoplastic elastomer portion and said substrate are of different materials having different hardness values which are selected so that the thermoplastic elastomer portion and the substrate are molded or bonded to one another without a separate adhesive layer therebetween, and the thermoplastic elastomer portion is more flexible than the substrate; and wherein said substrate includes a projection 34 extending from the exterior surface of the substrate, said projection being approximately perpendicular to a base portion of the substrate, and wherein said projection extending from the substrate does not contact said thermoplastic elastomer portion that includes the lip or leg that is for engaging the surface or edge of the vehicle window.

With regard to claim 10, the thermoplastic elastomer portion 61 comprises an approximately U-shaped connection portion (generally at an end thereof, see number “33”) comprising first and second elongated approximately parallel legs each of which engages a respective major surface of the polymer inclusive substrate in order to allow said attachment of the thermoplastic elastomer portion and the substrate, wherein an edge of said substrate fits into a

channel defined between the first and second elongated approximately parallel legs of the thermoplastic elastomer portion.

For claim 17, Dupuy '947 discloses an applique for use at a pillar area of a vehicle, the applique comprising: a polymer inclusive substrate 18, the polymer inclusive substrate including an interior surface to be closest to a vehicle window and an exterior surface to be further from the window than is the interior surface; a polymer inclusive flexible thermoplastic elastomer portion 61 including at least one flexible lip or leg for engaging a surface or edge of the vehicle window, wherein said substrate and said thermoplastic elastomer portion are "bonded" to each other at least on part of said interior surface of the substrate which is to be closest to the vehicle window; wherein said thermoplastic elastomer portion and said substrate are of different materials having different hardness values so that the thermoplastic elastomer portion is more flexible than the substrate; and wherein said substrate includes a projection 34 extending from the exterior surface of the substrate, said projection being approximately perpendicular to a base portion of the substrate, and wherein said projection extending from the substrate does not contact said thermoplastic elastomer portion that includes the lip or leg that is for engaging the surface or edge of the vehicle window.

With regard to the "bonded" and "molded" limitations, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

8. Claims 9 and 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly.

For claim 9, Kelly (6,103,168) discloses applique for use at a pillar area of a vehicle (Figure 1), the applique comprising: a polymer inclusive substrate 32, the polymer inclusive substrate including an interior surface to be closest to a vehicle window and an exterior surface to be further from the window than is the interior surface (Figure 3); a polymer inclusive flexible thermoplastic elastomer portion 34 including at least one flexible lip or leg for engaging a surface or edge of the vehicle window 46, wherein said substrate and said thermoplastic elastomer portion are “bonded” at least on part of said interior surface of the substrate which is to be closest to the vehicle window (Column 4, lines 31-38); wherein said thermoplastic elastomer portion and said substrate are of different materials having different hardness values which are selected so that the thermoplastic elastomer portion and the substrate are molded or bonded to one another without a separate adhesive layer therebetween, and the thermoplastic elastomer portion is more flexible than the substrate; and wherein said substrate includes a projection (Figure 3) extending from the exterior surface of the substrate 32, said projection being approximately perpendicular to a base portion of the substrate, and wherein said projection extending from the substrate does not contact said thermoplastic elastomer portion that includes the lip or leg that is for engaging the surface or edge of the vehicle window (see marked-up copy of Figure 3, hereto attached).

With regard to claim 12, the thermoplastic elastomer portion 34 at least partially defines a cavity, wherein one side of the cavity is defined by a first portion of the thermoplastic elastomer portion and another side of said cavity is defined by a portion of the thermoplastic elastomer portion that is to engage the window (see marked-up copy of Figure 3, hereto attached).

With regard to claim 13, the first portion of the thermoplastic elastomer portion that defines said one side of the cavity is bonded to the interior surface of the substrate.

With regard to claim 16, the projection extends from the exterior surface of the substrate, and the thermoplastic elastomer portion is at least partially attached to the interior surface of the substrate, so that the projection and thermoplastic elastomer portion are at least partially on opposite sides of the substrate.

For claim 17, Kelly '168 discloses an applique for use at a pillar area of a vehicle, the applique comprising: a polymer inclusive substrate 32, the polymer inclusive substrate including an interior surface to be closest to a vehicle window and an exterior surface to be further from the window than is the interior surface; a polymer inclusive flexible thermoplastic elastomer portion 34 including at least one flexible lip or leg for engaging a surface or edge of the vehicle window, wherein said substrate and said thermoplastic elastomer portion are "bonded" to each other at least on part of said interior surface of the substrate which is to be closest to the vehicle window; wherein said thermoplastic elastomer portion and said substrate are of different materials having different hardness values so that the thermoplastic elastomer portion is more flexible than the substrate; and wherein said substrate includes a projection extending from the exterior surface of the substrate, said projection being approximately perpendicular to a base portion of the substrate, and wherein said projection extending from the substrate does not contact said thermoplastic elastomer portion that includes the lip or leg that is for engaging the surface or edge of the vehicle window.

With respect to the various statements such as “for receiving” (claim 14) and “for use in” (claims 15 and 18), these limitations constitute intended use and do not add any structurally distinguishing features to the claimed invention.

With regard to the “bonded” and “molded” limitations, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly ‘168.

Kelly does not disclose the use of nylon as a substrate material. Kelly does suggest the use of olefins and polypropylene as a substrate material (Column 3, line 29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used any well known olefin, such as nylon, as a substrate material for the substrate of Kelly to provide optimum physical properties for a particular end use. Similarly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mixture of known materials as the substrate material to provide optimum properties for a particular end use.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **Any response to this action should be mailed to:**

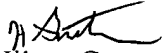
Assistant Commissioner for Patents
Washington, D.C. 20231

or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 746-3515, (for informal or draft communications, please clearly label
"PROPOSED" or "DRAFT").


Hilary Gutman

February 1, 2005



KELLY

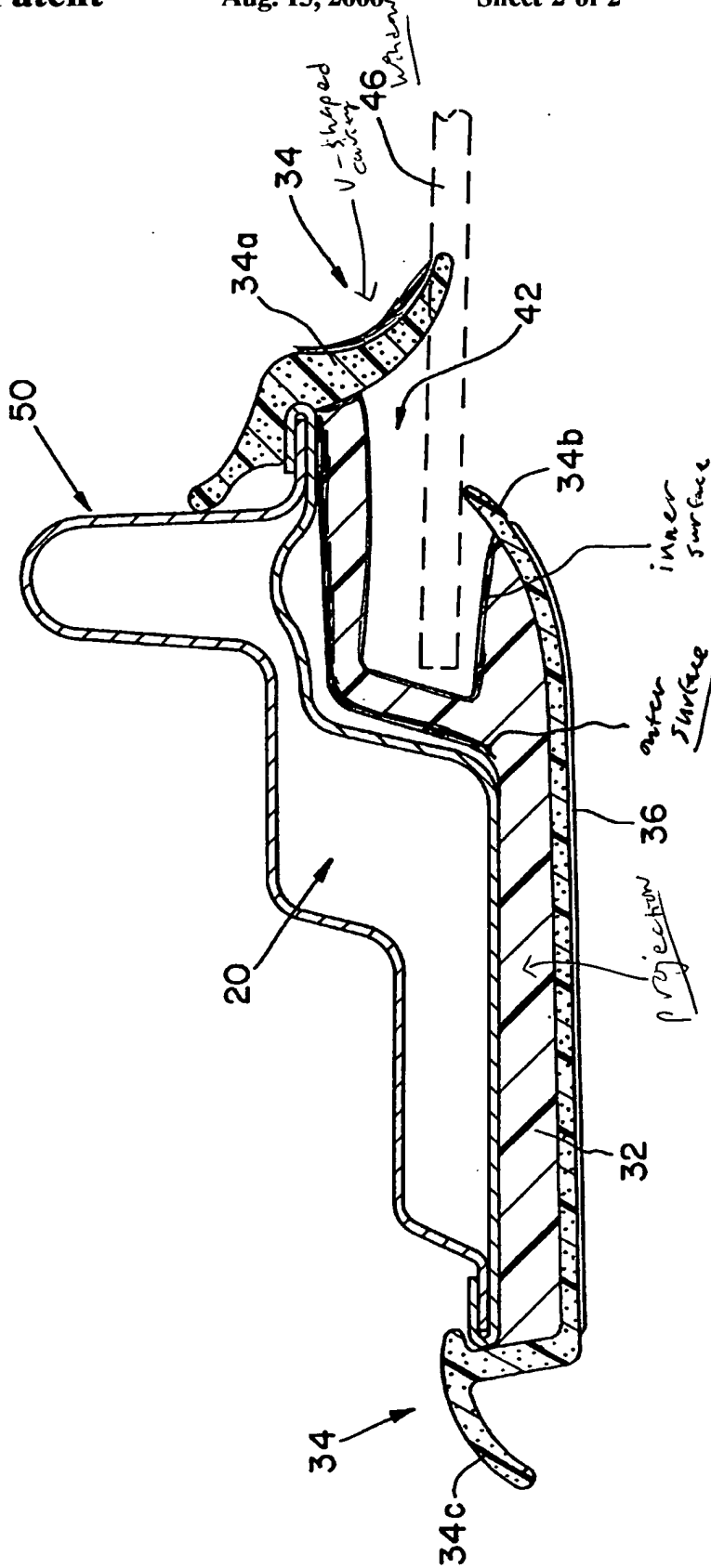


Fig. 3

(Marked-up copy)